

REMARKS

Applicant submits this Amendment and Response in reply to the outstanding Official Action of July 20, 2006 and submits that the Amendment and Response is fully responsive to the Official Action for at least the reasons set forth herein.

At the onset, Applicant notes that the claims have been amended herewith. Claim 1 has been amended to incorporate the subject matter of dependent Claim 3. Claims 2 and 3 have been cancelled. Claims 4-8 have been amended to correct a minor grammatical error; "a method" has been changed to "the method". The amendment to Claims 4-8 are neither narrowing nor a "substantial amendment related to patentability". Applicant notes that the cancellation of Claim 2 is without any prejudice to the subject matter of the claim being reintroduced into this application or introduced into a later filed related application.

Applicant submits that no new matter has been added to the application by way of the aforementioned amendments.

Applicant respectfully submits that amended Claim 1 is patentably distinct from the cited reference, Miya et al., U.S. Pat. Pub. 2003/0186725 (hereinafter "Miya"). Applicant submits that Miya fails to teach the limitation of wherein said plurality of channels comprise all but a selected one of said multiple channels and wherein, at step (ii), the correlation response is measured with reference to said selected one channel as recited in amended Claim 1.

Miya, at paragraphs 64 and 65 describes that a detection circuit calculates an amplitude and phase ratio of the reception signal by comparing a signal received point, e.g., r_1 with an identification point or a reference point. Miya defines this point as a reference identification point.

Miya neither expressly teaches nor inherently teaches that the reference identification point is a selected channel, i.e., reception signal from a selected channel. In fact, the Examiner recognizes this at page 3 of the Official Action. Moreover, Miya does not indicate that the identification point is inherently a selected channel. Applicant submits that the Examiner has failed to establish inherency.

There is no suggestion that the claimed features must be present in the prior art system. Under U.S. patent law, inherency of a property or other feature possessed by a thing must be certain. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. That which may be inherent is not necessarily known, and anticipation or obviousness (35 U.S.C. § 103) cannot be predicated on what is unknown. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). *See also Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981), and *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 U.S.P.Q.2d 1017 (Fed. Cir. 1994). The CAFC in *In re Robertson* 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999), reversed the Board's finding of anticipation by inherency because the Board "ignored the foregoing critical principles", established by *Continental Can* and *In re Oelrich*, stating, at 745, at 1950-51, respectively:

"Anticipation under 35 U.S.C. § 102(e) requires that 'each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.' *Verdegaal Bros., Inc., v. Union oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

"If a prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that

element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing in the reference, and that it would be so recognized by persons of ordinary skill'. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *Id.* At 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326, (C.C.P.A. 1981)."

The law requires the Examiner to provide the necessary factual support for his position. If not, he must otherwise withdraw the rejection. However, in presenting his arguments, the Examiner has not demonstrated that "the missing descriptive matter is necessarily present in the thing in the reference, and that it would be so recognized by persons of ordinary skill". The reference fails to give any indication as to what the reference identification point is other than labeling the reference point in Figures 11c and 11d as "a". However, Applicant notes that in Figure 11a, which illustrates the primary modulation, there appears to be a "dot" located in the same position is the reference point of Figures 11c and 11d. The "dot" does not represent a receiver signal in an antenna or channel.

Miya, therefore, does not adequately describe the reference identification point such that one of ordinary skill in the art would be able to understand that the reference identification point is a selected channel. To the contrary, this contention is purely a product of the Examiner's conjecture. In fact, the reference describes a comparison between each of the two channels and the reference identification point, and not one of the channels with the other channel, i.e., no direct channel comparison. Had Miya intended for one channel to be selected as the reference point, Miya could teach a comparison between the output signals from the two illustrated reception antenna. However, the only comparison described refers to only a comparison of

amplitude ratio and phase difference to the reference identification point. In Miya, the reference identification point could easily be the calibration signal itself. Therefore, the Examiner has not established that this limitation must be present in Miya or even is implicitly taught in Miya.

In contrast, amended Claim 1 clearly recites that one channel is used to act as a reference channel and is directly compared with the remaining channels. As such, the claimed invention is fundamentally different from the cited reference.

The claimed invention has a significant advantage over Miya. An assumption regarding the calibration signal is not needed in the claimed invention in order to perform the calibration, i.e., no assumptions by the detection circuit. Additionally, since the claimed invention directly compares a selected channel with the remaining channels, any variations in the calibration signal with time is not relevant and, therefore, the measurement can be accurate.


Accordingly, Applicant respectfully submits that amended Claim 1 is patentable over the cited reference; the reference fails to teach and describe, each and every limitation of the claim. Claims 4-8 are patentably distinct from Miya based at least upon the above-identified analysis, in view of their dependency from Claim 1.

Based upon the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1-8 pursuant to 35 U.S.C. § 102(a).

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicit the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of

this application, the Applicant respectfully requests that the Examiner call the undersigned,
Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,


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